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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,573	11/24/2003	Kiyoshi Yuri	03696/LH	9922
1933 7590 02/09/2009 FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708				
EXAMINER CZEKAJ, DAVID J				
ART UNIT 2621		PAPER NUMBER		
MAIL DATE 02/09/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/723,573

Applicant(s)

YURI, KIYOSHI

Examiner

DAVID CZEKAJ

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/2/08 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1-3 and 9 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 9 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101"). The instant claims neither transform underlying subject matter nor positively tie to another statutory

category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. While the preamble of the claim recites the method is for use with a microscopic image capture apparatus, there is nothing in the inventive step of the claim that limits the capturing, extracting, replacing, reading, and computing to an electronic form. Hence, the claim is not tied to another statutory category or transforms underlying subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglass et al. (6215892), (hereinafter referred to as "Douglass") in view of Gagnon et al. (7027628), (hereinafter referred to as "Gagnon").

Regarding claim 1, as shown in Figure 2, Douglass teaches a system for a microscopic image capture apparatus. The apparatus includes a low magnification optical system and a high magnification optical system (44 and 44a, Fig. 4). Note, the turret (44) changes the magnification. The system further includes the hardware to provide an automated scanning for candidate cells at a low magnification, refocusing at a higher magnification and performing further analysis to confirm the cell candidate (Col 5 Line 55-Col 6 Line 10). The system

is run by a system processor (23) and microscope controller (31) (Col 5 Lines 20-34).

The system performs the operation of capturing an image of a wide-angle view of an entire observing slide by a low magnification optical system and extracting a sample image area including a sample image from the captured image of wide-angle view (Col 10 Lines 12-21).

Douglass further teaches one method of performing auto focus at a high magnification is to automatically set a plurality of horizontal positions in which a height coordinate Z is acquired from the extracted sample image area and reading a height coordinate which is a focal point position of the high magnification optical system in each of the set horizontal positions (Col 11 Lines 9-12, Col 11 Lines 24-40, Col 12 Lines 20-26). Once the focus positions are obtained for the set horizontal positions, adjusted position of a focal point in an arbitrary position in the sample image area using the set horizontal positions and height coordinate data is computed (Col 11 Lines 57-65). The height value is used to adjust the microscope in order to capture an image (Col 11 Lines 61-62). However, Douglass fails to disclose the Z coordinate calculation as claimed. Gagnon teaches that prior art processing systems tend to have slides that deteriorate over time and are unavailable (Gagnon: column 1, lines 59-67). To help alleviate this need, Gagnon teaches automatically setting a plurality of positions over the sample in each of which a height coordinate Z is acquired (Gagnon: column 6, lines 35-67; column 7, lines 1-32. By applying correction

data to the Z position, the current Z position must be known in order to apply the proper amount of correction data). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to take the apparatus disclosed by Douglass and add the Z processing taught by Gagnon in order to help increase the life of the slides and the available of the samples.

Regarding claims 2-3, Douglass further teaches the apparatus uses a grid of points centered on the scan area and obtains focus positions using the auto-focusing method of Figure 13a (Col 11 Lines 41-56, Figs 14 and 15). As shown in Figure 15, the grid points are at predetermined intervals.

Regarding claim 9, note the examiners rejection for claim 1.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID CZEKAJ whose telephone number is (571)272-7327. The examiner can normally be reached on Mon-Thurs and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on (571) 272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dave Czekaj/
Primary Examiner, Art Unit 2621